

REMARKS

Claim Amendments

By this Amendment, Applicants have amended claim 72 to overcome the 35 U.S.C. § 101 rejection. Claims 37, 38, 40-55, and 57-74 are pending and under current examination.

Office Action

Applicants respectfully traverse the rejections made in the Office Action, wherein the Examiner:

- (a) rejected claims 72 under 35 U.S.C. § 101;
- (b) rejected claim 73 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,542,733 B1 (“Dennis”) in view of U.S. Patent No. 6,360,108 B1 (“Rogers”); and
- (c) indicated that claims 37, 38, 40-55, 57-71, and 74 are allowed.

Allowable Subject Matter

Applicants acknowledge with appreciation the Examiner’s indication that claims 37, 38, 40-55, 57-71, and 74 are allowed. *See* Office Action, p. 5.

Rejection of Claim 72 under 35 U.S.C. § 101

Applicants request reconsideration and withdrawal of the rejection of claim 72 under 35 U.S.C. § 101, as being allegedly directed to non-statutory subject matter. In particular, the Office Action alleges that “[t]he preamble of claim 72 ‘A computer-readable medium’ lacks proper support in the specification, i.e., the specification does not state, or given example [of] what [] ‘a computer-readable medium’ [is]. [] Therefore, it is a transitory signal[] per se.” Office Action, p. 2. Applicants respectfully disagree.

First, Applicants note that the recitation of “[a] computer-readable medium” is supported by specification at, for example, p. 4, lines 31-36. Second, without conceding to the Office Action’s allegations, Applicants have amended claim 72 to recite “[a] non-transitory

computer-readable medium” (emphasis added). *See Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101* (Aug. 2009) (“a claim to a non-transitory, tangible computer readable storage medium *per se* that possesses structural limitations under the broadest reasonable interpretation standard to qualify as a manufacture would be patent-eligible subject matter.” *Interim Instructions* at 4.

Applicants therefore respectfully request withdrawal of the 35 U.S.C. § 101 rejection.

Rejection of Claim 73 under 35 U.S.C. § 103(a)

Applicants request reconsideration and withdrawal of the rejection of claim 73 under 35 U.S.C. § 103(a) as being unpatentable over Dennis in view of Rogers. *See* Office Action, pp. 3-4. Applicants note that claim 73 was added in the Amendment filed on October 5, 2009, responsive to the Office Action mailed on May 5, 2009. In that Office Action, the Examiner indicated that claim 41 was allowable. *See* Office Action mailed May 5, 2009, p. 12. As pointed out in the Amendment filed on October 5, 2009, claim 73 incorporates all of the features of original claim 37 and allowable claim 41, and therefore, should also be allowable. By rejecting claim 73 in the present Office Action, the Examiner is inconsistent with his indication that claim 41 is allowed.

Nevertheless, claim 73 (and claim 41) is still allowable over Dennis and Rogers. Claim 73 recites, among other things, the following features:

receiving from the user of the terminal information relating to a location of said terminal and the operation of switching said user identifiers between said first configuration and said second configuration following the receipt of the information.

Dennis and Rogers, whether taken alone or in combination, do not teach or suggest the above-quoted features. Dennis discloses “[a] system and method . . . for providing personal dialing profiles for users of wireless devices.” Dennis, Abstract. According to Dennis’ system

and method, “[t]he personal profile lists allow users to dial only an abbreviated portion of the telephone number and then the wireless network adds any other required digits, such as country, area or local exchange codes.” *Id.* The Office Action refers to col. 4, lines 5-10, and col. 5, lines 22-34 of Dennis for its alleged disclosure of the above-quoted features of claim 73. However, these portions of Dennis fail to teach or suggest the features of claim 73. For example, col. 4, lines 4-10 of Dennis merely discloses:

[I]f caller 101 wants to use a particular long distance service provider of a certain call, then he/she must first dial routing codes, such as a “10XXX” or “1-800” number used by the long distance service provider. Caller 101 may also need to enter access or billing codes for the selected long distance service, such as an account number or personal identification number (PIN), in order to use the service.

Contrary to the Office Action’s allegations, this portion of Dennis teaches nothing relating to “receiving from the user of the terminal information relating to a location of said terminal and the operation of switching said user identifiers between said first configuration and said second configuration following the receipt of the information,” as recited in claim 73 (emphases added).

Similarly, col. 5, lines 22-34 of Dennis merely discloses that “[s]ubscribers can also automatically add numbers to their personal profile calling list when they dial a telephone number on wireless device 101,” and teaches nothing relating to “receiving from the user of the terminal information relating to a location of said terminal and the operation of switching said user identifiers between said first configuration and said second configuration following the receipt of the information,” as recited in claim 73 (emphases added).

In fact, other portions of Dennis also do not teach or suggest, among other things, “receiving from the user of the terminal information relating to a location of said terminal,” as recited in claim 73 (emphases added). In contrast, Dennis teaches that “the network determines the user’s current location,” such as by identifying a particular cell or sector that is in

communication with the user.” Dennis, col. 6, lines 32-35 (emphasis added). Moreover, Dennis fails to teach or suggest that “the operation of switching said user identifiers between said first configuration and said second configuration follow[s] the receipt of the information,” as recited in claim 73.

The Office Action then relies on Rogers to allegedly teach “a country prefix and a local prefix.” Office Action, p. 4. The Office Action does not allege that Rogers teaches “receiving from the user of the terminal information relating to a location of said terminal and the operation of switching said user identifiers between said first configuration and said second configuration following the receipt of the information,” as recited in claim 73. Indeed, Rogers merely discloses a “system and method for the automatic prepending of digits in a wireless communication device.” Rogers, Title. Rogers’ system and method, however, teach nothing relating to the above-quoted features of claim 73. Thus, Rogers does not cure the deficiencies of Dennis.

Dennis and Rogers, whether taken alone or in combination, do not teach or suggest each and every feature of claim 73 (and claim 41). Claim 73 (and claim 41) is nonobvious, and should be allowable over the cited references. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 73.

Conclusion

Pending claims 37, 38, 40-55, and 57-74 are in condition for allowance, and Applicants request a favorable action.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 15, 2010

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